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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,925	12/05/2001	Carl Phillip Gusler	AUS920011013US1	9805

7590

07/05/2005

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EXAMINER
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NEURAUTER, GEORGE C

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 07/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/004,925

Applicant(s)

GUSLER ET AL.

Examiner

George C. Neurauter, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 03142005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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**DETAILED ACTION**

Claims 1-30 are currently presented and have been examined.

***Response to Arguments***

Applicant's arguments, see pages 9-15 of the response filed 20 April 2005, with respect to the rejection(s) of claim(s) 1-30 under 35 USC 102 using Donahue have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Donahue under 35 USC 103(a).

In response to applicant's argument that there is no suggestion to combine the references regarding the limitations in claims 2, 5, 6, 12, 15, 16, 22, 25 and 26 including implementing the method in an instant messaging provider, providing the at least one portion of the transcript to a designated monitor including transmitting the at least one portion of the transcript as an email attachment, and transmitting the email in response to a request from the designated monitor, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*,

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837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Examiner has established a case of prima facie obviousness regarding the modification of Donahue and the combination of Donahue and Fertell which are based on the teachings and suggestions found in the references.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 7, 8, 11, 17, 18, 21, 27, and 28 rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication 2002/0004907 A1 to Donahue.

Regarding claim 1, Donahue discloses a method of monitoring use of an instant messaging user account, comprising:

receiving an instant message from a destination user (referred to within the reference as "chat session"; paragraph 0004);

storing the transcript of the received instant message in a storage device in response to determining that the transcript is desired; (paragraph 0011)

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analyzing ("processing") the transcript for occurrences of questionable content to thereby identify at least one portion of the transcript having questionable content; (paragraphs 0015, 0016 and 0018) and

providing the at least one portion of the transcript to a designated monitor of the instant messaging source user account ("user"). (paragraph 0006, last sentence)

Donahue does not expressly disclose searching a registry that identifies a set of approved destination users to determine if a transcript of the received instant message is desired, wherein the transcript is not desired if the destination user is identified in the registry as being an approved destination user, and wherein the transcript is desired if the destination user is not identified in the registry as being an approved destination user, however, Donahue does disclose searching a registry that identifies text to determine if a transcript of the received instant message is desired, wherein the transcript is not desired if the text is identified in the registry as being an approved text, and wherein the transcript is desired if the destination user is not identified in the registry as being an approved text (paragraph 0017 and 0021). Donahue also contemplates wherein chat sessions are to be monitored with the present invention (paragraph 0004 and 0006). Donahue also

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discloses that any text may be used to determine if a transcript of the received instant message is desired (paragraph 0015 and 0016) and that the text may include a destination user's name or electronic address (paragraph 0023-0025, specifically "From: "John Doe" <johndoe@company-a.net>")

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Donahue to have a registry of destination users to determine if a transcript of the received instant message is desired since Donahue discloses that destination users are part of the text of a communication message (paragraph 0023-0025, specifically "From: "John Doe" <johndoe@company-a.net>") and discloses that instant messages are contemplated to be used with the invention (see above). Also, Donahue discloses that the determining can be accomplished by setting a threshold value of a regular expression which may include any text including a source user and a destination user and that when the threshold value is met, a transcript is desired (paragraph 0021). Therefore, one of ordinary skill in the art would have found it obvious that by setting the initial threshold value to a high enough value to where any communication message is saved by basing the initial threshold value to the desired source user account name or electronic address which is stored within the registry and that

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when a destination user is identified, a negative threshold value (paragraph 0019) is used to bring the threshold value below the threshold so that the communication message is not saved. Therefore, it would have been obvious to achieve the limitations of the claim.

Regarding claim 7, Donahue discloses the method of claim 1, wherein providing the at least one portion of the transcript to a designated monitor includes generating a web page through which the at least one portion of the transcript is provided to the designated monitor. (paragraph 0028)

Regarding claim 8, Donahue discloses the method of claim 1, further comprising:

identifying at least one transcript characteristic ("category") of the transcript; updating at least one instant messaging account characteristic ("keyword match") based on the at least one transcript characteristic; (paragraphs 0015 and 0016) and

providing the at least one instant messaging account characteristic to the designated monitor of the instant messaging source user account. (paragraph 0028)

Claims 11, 17, and 18 are rejected since these claims recite an apparatus that contain substantially the same limitations as recited in claims 1, 7, and 8 respectively.



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Claims 21, 27, and 28 are rejected since these claims recite a computer program product that contain substantially the same limitations as recited in claims 1, 7, and 8 respectively.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered

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therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 2-6, 10, 12-16, 20, 22-26, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donahue.

Regarding claim 2, Donahue discloses the method of claim 1.

Donahue does not expressly disclose wherein the method is implemented in an instant messaging service provider of a distributed data processing system, however, Donahue does disclose wherein the method may be implemented anywhere where the monitoring is able to be implemented (paragraph 0006, the sentence "The present invention monitors...")

It would have been obvious to one skilled in the art at the time the invention was made to implement the method in an instant messaging service provider because the Applicant has not disclosed that using the limitation undisclosed in Donahue provides any sort of an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention

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to perform equally well with the method described in Donahue as recited in the claim because, in view of the disclosures of Donahue, the method may be implemented anywhere where the communication may be monitored and it would have been obvious to have the method execute anywhere within a network system as the method would work equally well regardless of where the method is implemented.

Regarding claim 3, Donahue discloses the method of claim 1.

Donahue does not expressly disclose wherein the method is implemented in a network service provider of a distributed data processing system, however, Donahue does disclose wherein the method may be implemented anywhere where the monitoring is able to be implemented (paragraph 0006, the sentence "The present invention monitors...")

Claim 3 is rejected since the motivations regarding the obviousness of claim 2 also apply to claim 3.

Regarding claim 4, Donahue discloses the method of claim 1.

Donahue does not expressly disclose wherein the method is implemented in a client device of a distributed data processing system, however, Donahue does disclose wherein the method may be implemented anywhere where the monitoring is able to be implemented (paragraph 0006, the sentence "The present invention monitors...")

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Claim 4 is rejected since the motivations regarding the obviousness of claim 2 also apply to claim 4.

Regarding claim 5, Donahue discloses the method of claim 1.

Donahue does not expressly disclose wherein providing the at least one portion of the transcript to a designated monitor includes transmitting the at least one portion of the transcript as an attachment to an electronic mail message, however, Donahue does disclose providing the at least one portion of the transcript to a designated monitor by transmitting the at least one portion of the transcript as a web page or other means (paragraph 0006, last sentence; paragraphs 0028 and 0029). Donahue also contemplates the use of attachments within an email (paragraph 0014, specifically the sentence "For instance, email may contain...")

It would have been obvious to one skilled in the art at the time the invention was made to use the method of transmitting the at least one portion of the transcript by a web page because the Applicant has not disclosed that using the limitation undisclosed in Donahue provides any sort of an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the method of transmitting described in Donahue as recited in the claim

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because the transcript can be received by the user regardless of the manner the transcript is sent.

Regarding claim 6, Donahue discloses the method of claim 5.

Donahue does not disclose wherein the electronic mail message is transmitted in response to a request from the designated monitor, however, Donahue does disclose wherein the at least one portion of the transcript is transmitted in response to a request from the designated monitor (paragraph 0006, last sentence; paragraph 0028)

Claim 6 is rejected since the motivations regarding the obviousness of claim 5 also apply to claim 6.

Regarding claim 10, Donahue discloses the method of claim 1.

Donahue does not expressly disclose wherein analyzing the transcript includes filtering for text including at least one of proper names, addresses and phone numbers, however, Donahue does disclose wherein analyzing the transcript includes filtering for text (paragraphs 0017 and 0018). Donahue discloses that any text may be filtered (paragraphs 0015, the sentences "The remainder..." and "This allows the language elements...").

It would have been obvious to one skilled in the art at the time the invention was made to use the method of analyzing the transcript by filtering for any text because the Applicant has

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not disclosed that using the limitation undisclosed in Donahue provides any sort of an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the method of filtering described in Donahue as recited in the claim because any text may be filtered regardless of the sort or type of text to be filtered in view of the disclosures of Donahue.

2. Claims 9, 19, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donahue as applied to claim 1 above, and further in view of US Patent Application Publication 2002/0032770 to Fertil et al.

Regarding claim 9, Donahue discloses the method of claim 8.

Donahue does not disclose wherein the at least one instant messaging account characteristic includes at least one of a ranked list of user identifications for most frequent incoming instant messages, a ranked list of user identifications for most frequent outbound target user identifications, a ranked list of most frequent recent incoming or outbound user identifications, a date/time distribution of instant messages that provides contact patterns for a particular user identification, and tracking of the contact patterns for the particular user identification, however, Donahue does disclose a instant

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messaging account characteristic ("keyword match"; paragraphs 0015 and 0016). Donahue also suggests that other instant messaging account characteristics may be used (paragraph 0028, the sentences "To enhance ease-of-use..." and "In addition, all bar graph...")

Fertell discloses a instant messaging account characteristic which includes a date/time distribution of instant messages (paragraphs 0010 and 0035).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of these references since Fertell discloses that using a date/time distribution enables a date/time reference to be stored with the transcript ("log") (paragraph 0035, last paragraph). In view of these specific advantages and that both references are directed to monitoring use an instant messaging account, one of ordinary skill would have been motivated to combine these references and would have considered them to be analogous to one another based on their related fields of endeavor.

Claims 19 and 29 are also rejected since these claims recite an apparatus and computer program product that contain substantially the same limitations as recited in claim 9.

#### **Conclusion**

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following prior art teaches a well-known protocol of instant messaging using text-based messaging:

Oikarinen, J. and Reed, D. "Request for Comments (RFC) 1459: Internet Relay Chat Protocol", Network Working Group, May 1993, 65 pages.

The following prior art teaches instant messaging monitoring methods and means:

US Patent 5 848 148 to de Souza et al;

US Patent 5 987 606 to Cirasole et al;

US Patent 6 076 100 to Cottrille et al;

US Patent 6 260 041 to Gonzalez et al;

US Patent 6 332 141 to Gonzalez et al;

US Patent 6 606 644 to Ford et al;

US Patent 6 631 412 to Glasser et al;

US Patent 6 633 855 to Auvenshine;

US Patent Application Publication 2001/0000192 to Gonzalez et al;

US Patent Application Publication 2001/0018687 to Gonzalez et al;

US Patent Application Publication 2001/0032203 to Gonzalez et al;



US Patent Application Publication 2002/0049806 to Gatz et al;

US Patent Application Publication 2002/0124053 to Adams et al;

US Patent Application Publication 2002/0174183 to Saeidi.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C.

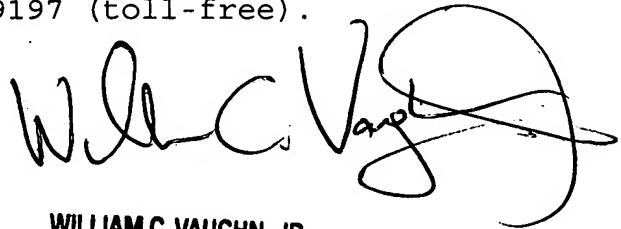
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Neurauter, Jr. whose telephone number is (571) 272-3918. The examiner can normally be reached on Monday through Friday from 9AM to 5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gcn

A handwritten signature in black ink, appearing to read "William C. Vaughn, Jr.", with a large, stylized flourish at the end.

WILLIAM C. VAUGHN, JR.  
PRIMARY EXAMINER

27 June 05